

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors:	Gregg S. Schmidtk, et al.	Examiner:	Sarah L. Purol
Serial No.:	10/677,709	Group Art Unit:	3637
Filed:	October 2, 2003	Docket No.:	200300049-1
Title:	Apparatus and Method for Mounting a Device to a Rack System		

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the Final Office Action mailed November 5, 2009 and Notice of Appeal mailed February 5, 2010.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 11445 Compaq Center Drive West, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences known to Appellant, Appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 – 3 and 5 – 13 are pending in the application and are finally rejected. Claim 4 is withdrawn, and claims 14 – 20 are canceled. The rejection of claims 1 – 3 and 5 – 13 is appealed.

IV. STATUS OF AMENDMENTS

No amendments were made after receipt of the Final Office Action. All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R. § 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element or that these are the sole sources in the specification supporting the claim features.

Claim 1

An apparatus (Fig. 1, #150) for mounting an electronic device (Fig. 1, #100) to a rack system (Fig. 1, #110), comprising:

a frame assembly; (Fig. 1, #120: p. 4, lines 9-10: The rack system 110 comprises a frame assembly 120.)

at least two rails (Figs. 1, 2, and 5, #200/201) mounted on opposite sides of the frame assembly; (Rail 200 is mounted to posts 121/122 and rail 201 is mounted to posts 123/124: p. 6, lines 23-26)

a plurality of hangers (Figs. 3, 4a, 4b, 5, #300) provided on opposite sides of the electronic device, said plurality of hangers retracting into the opposite sides so the electronic device can fit into said frame assembly between said at least two rails and then said plurality of hangers expanding from the opposite sides to engage said at least two rails and to support the electronic device on said at least two rails in the frame assembly. (Hangers are provided on opposite sides of the device: p. 7, lines 17-21. Hangers slide through channels 210 formed in the rail 200: p. 7, lines 22-25. Hangers maintain the device in the rack: p. 9, lines 19-20).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 7, and 10 are rejected under 35 USC § 102(b) as being anticipated by USPN 5,993,099 (Greenberg).

Claims 2 and 3 are rejected under 35 USC § 102(b) as being anticipated by USPN 6,209,979 (Fall).

Claims 5, 6, 8, 9, 11, 12, and 13 are rejected under 35 USC § 103(a) as being unpatentable over USPN 5,993,099 (Greenberg) in view of USPN 5,967,337 (Fitzburgh).

VII. ARGUMENT

The rejection of claims 1 – 3 and 5 – 13 is improper, and Appellants respectfully request reversal of these rejections.

The claims do not stand or fall together. Instead, Appellants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

Claim Rejections: 35 USC § 102(b)

Claims 1, 7, and 10 are rejected under 35 USC § 102(b) as being anticipated by USPN 5,993,099 (Greenberg). These rejections are traversed since claims 1, 7, and 10 recite elements not taught in Greenberg.

Principles of Law: Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification (see *In re Prater*, 415 F.2d 1393,1404-05 (CCPA 1969); *In re Am. A cad. a/Sci.Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Although a patent applicant is entitled to be his or her own lexicographer of terms in a claim, in *ex parte* prosecution the lexicography must be within limits. *In re Carr*, 347 F.2d 578,580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. See also *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Principles of Law: Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. a/California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349,1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831,832 (Fed. Cir. 1990).

Sub-Heading: Claims 1, 7, and 10

Independent claim 1 is selected for discussion.

As one example, independent claim 1 recites a plurality of hangars provided on opposite sides of the electronic device. By contrast, Greenberg teaches hangars that extend from a file folder, not an electronic device.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, claims 1, 7, and 10 are allowable over Greenberg.

As another example, independent claim 1 recites that the hangars retract into the opposite sides so the electronic device can fit into the frame assembly. By contrast in Greenberg, the hangars do not retract so the file folder can fit between the rails.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, claims 1, 7, and 10 are allowable over Greenberg.

As another example, claim 1 recites an apparatus for mounting an electronic device to a rack system. Although these recitations appear in the preamble, the terms in the preamble provide life and meaning to the body of the claim. Greenberg teaches a file folder for paper documents, not “for mounting an electronic device to a rack system.”

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, claims 1, 7, and 10 are allowable over Greenberg.

As yet another example, independent claim 1 recites that the plurality of hangars “support the electronic device” on the rails. By contrast, Greenberg teaches hangars that support a notebook folder.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, claims 1, 7, and 10 are allowable over Greenberg.

Sub-Heading: Claim 7

Dependent claim 7 recites that two of said plurality of hangars are provided on opposite sides of the electronic device and biasably expand from chambers formed in the opposite sides. By contrast, Greenberg teaches hangars that extend from a file folder, not provided on opposites sides of an electronic device. Furthermore, the hangars in Greenberg do not biasably expand from chambers formed in the opposite sides of the electronic device.

For at least these reasons, dependent claim 7 is not anticipated by Greenberg.

Claim Rejections: 35 USC § 102(b)

Claims 2 and 3 are rejected under 35 USC § 102(b) as being anticipated by USPN 6,209,979 (Fall). These rejections are traversed.

The examiner has failed to establish a prima facie case to reject claims 2 and 3. Specifically, dependent claims 2 and 3 dependent from independent claim 1. The examiner has not identified locations in Fall that allegedly teach the elements of independent claim 1. The examiner has only addressed the claim elements of dependent claims 2 and 3. Therefore, the examiner has failed to establish a prima facie case in rejecting dependent claims 2 and 3 since these claims, by nature of their dependency, include the recitations of independent claim 1.

Furthermore, independent claim 1 recites that that the hangars retract into the opposite sides so the electronic device can fit into the frame assembly. By contrast, the hangars in Fall are fixed.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, dependent claims 2 and 3 are allowable over Fall.

As another example, independent claim 1 recites that the hangars expand from opposite sides of the electronic device. By contrast, the hangars in Fall are fixed.

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed (see *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985)).

For at least these reasons, dependent claims 2 and 3 are allowable over Fall.

Sub-Heading: Claim 3

Dependent claim 3 recites that plurality of hangers biasably release from the opposite sides to engage said at least two rails. By contrast, the hangars in Fall are fixed.

For at least these reasons, dependent claim 3 is allowable over Fall.

Claim Rejections: 35 USC § 103(a)

Claims 5, 6, 8, 9, 11, 12, and 13 are rejected under 35 USC § 103(a) as being unpatentable over USPN 5,993,099 (Greenberg) in view of USPN 5,967,337 (Fitzburgh).

These rejections are traversed.

Principles of Law: Obviousness

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered”

because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385.

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Differences Between the Art and Claims

Claims 5, 6, 8, 9, 11, 12, and 13 recite one or more elements that are not taught or suggested in Greenburg in view of Fitzburgh. These missing elements show that the differences between the combined teachings in the art and the recitations in the claims are great. As such, the pending claims are not a predictable variation of the art to one of ordinary skill in the art.

As explained above, independent claim 1 recites elements not taught or even suggested in Greenberg. Fitzburgh fails to cure these deficiencies. For at least the reasons given with respect to independent claim 1, dependent claims 5, 6, 8, 9, 11, 12, and 13 are allowable over Greenberg in view of Fitzburgh.

Sub-Heading: Claim 9

Dependent claim 9 recites that the plurality of hangers are triangular-shaped. The examiner has failed to establish a prima facie case to reject this claim. The examiner has not cited a location in either Greenberg or Fitzburgh for teaching or suggesting hangars with a triangular-shape. Greenberg or Fitzburgh do not teach or suggest hangars with a triangular-shape.

For at least these reasons, dependent claim 9 is allowable over Greenberg in view of Fitzburgh.

CONCLUSION

In view of the above, Appellants respectfully request the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

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VIII. Claims Appendix

1. An apparatus for mounting an electronic device to a rack system, comprising:
 - a frame assembly;
 - at least two rails mounted on opposite sides of the frame assembly; and
 - a plurality of hangers provided on opposite sides of the electronic device, said plurality of hangers retracting into the opposite sides so the electronic device can fit into said frame assembly between said at least two rails and then said plurality of hangers expanding from the opposite sides to engage said at least two rails and to support the electronic device on said at least two rails in the frame assembly.
2. The apparatus of claim 1, wherein the plurality of hangers slide in a channel formed in each of said at least two rails as the electronic device slides into and out of the frame assembly.
3. The apparatus of claim 1, wherein said plurality of hangers biasably release from the opposite sides to engage said at least two rails.
4. The apparatus of claim 1, wherein the electronic device is a computer server, router, or disk storage.
5. The apparatus of claim 1, wherein said frame assembly comprises a plurality of posts, the electronic device is supported in said frame assembly between said

plurality of posts.

6. The apparatus of claim 1, wherein said at least two rails are mounted between adjacent posts of said frame assembly.

7. The apparatus of claim 1, wherein two of said plurality of hangers are provided on opposite sides of the electronic device and biasably expand from chambers formed in the opposite sides.

8. The apparatus of claim 1, wherein said plurality of hangers are cylindrical.

9. The apparatus of claim 1, wherein said plurality of hangers are triangular-shaped.

10. The apparatus of claim 1, wherein at least one of said plurality of hangers comprises a ramp portion.

11. The apparatus of claim 10, wherein the ramp portion engages said frame assembly to automatically retract the at least one hanger.

12. The apparatus of claim 1, wherein at least one of said plurality of hangers comprises a stop portion.

13. The apparatus of claim 12, wherein the stop portion engages said frame assembly to prevent said electronic device from sliding beyond a predetermined position in said frame assembly.

14. – 20. (canceled)

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.